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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/802,652

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Narumi Koga

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REED SMITH, LLP

ATTN: PATENT RECORDS DEPARTMENT

599 LEXINGTON AVENUE, 29TH FLOOR

NEW YORK, NY 10022-7650

EXAMINER

SHAH, MANISH S

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/802,652	<b>Applicant(s)</b> KOGA ET AL.	
	<b>Examiner</b> Manish S. Shah	<b>Art Unit</b> 2853	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13 and 15-20 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/30/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 13 & 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouchi et al. (# US 2001/0045175) in view of Fukui. (# JP 2000-191973).

Ouchi et al. discloses a water-based ink for ink jet recording including a dispersible coloring agent ([0067]-[0071]); a propylene glycol ether ([0063]); and a surfactant ([0071]). They also disclose that the amount of the propylene glycol ether is 0 to 30% by weight ([0063]) and surfactant is added in amount from 0.1 to 3% (see Examples). They also disclose that the content ratio by weight of propylene glycol ether/surfactant is 5 to 10 (see Examples). They also disclose an inkjet printer including an inkjet head, which has an ink flow passage, and the ink cartridge to accommodate the ink ([0076]).

Ouchi et al. discloses all the limitation of the water-based ink except that the surfactant represented by the general formula:  $R_1-O-(CH_2CH_2O)_n-SO_3M$ , wherein  $n$  represents an integer of 2 to 4,  $R_1$  represents an alkyl group having a number of carbon atoms of 12 to 15 and  $M$  represents Na or triethanolamine.

Fukui teaches that the ink composition having the good storage stability characteristics, the ink composition includes a surfactant, which has a general formula  $R-O-(CH_2CH_2O)_n-SO_3M$ , wherein  $n$  is 2 to 50,  $R$  is alkyl group having 8 to 20 carbon atom, and  $M$  is organic amines or alkanolamines (see Abstract; [0008]-[0010]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the ink composition of Ouchi et al. by the aforementioned teaching of Fukui in order to have the good storage stability ink composition.

2. Claims 13 & 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kappele et al. (# US 6063834) in view of Fukui. (# JP 2000-191973).

Kappele et al. discloses a water-based ink for ink jet recording including a dispersible coloring agent (column: 6, line: 3-67); a propylene glycol ether (column: 4, line: 38-45); and a surfactant (column: 4, line: 43-50). They also disclose that the amount of the solvent is added is preferably 10 to 60% by weight (column: 8, line: 5-15) and surfactant is added in amount from 0.1 to 5% (see Examples). They also disclose that the content ratio by weight of propylene glycol ether/surfactant is 5 to 10 (see Examples). They also disclose an inkjet printer including an inkjet head, which has an ink flow passage, and the ink cartridge to accommodate the ink (column: 8, line: 30-50).

Kappele et al. discloses all the limitation of the water-based ink except that the surfactant represented by the general formula:  $R_1-O-(CH_2CH_2O)_n-SO_3M$ , wherein  $n$  represents an integer of 2 to 4,  $R_1$  represents an alkyl group having a number of carbon atoms of 12 to 15 and  $M$  represents Na or triethanolamine.

Fukui teaches that the ink composition having the good storage stability characteristics, the ink composition includes a surfactant, which has a general formula  $R-O-(CH_2CH_2O)_n-SO_3M$ , wherein  $n$  is 2 to 50,  $R$  is alkyl group having 10 to 20 carbon atom, and  $M$  is organic amines or alkanolamines (see Abstract; [0008]-[0010]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the ink composition of Kappeler et al. by the aforementioned teaching of Fukui in order to have the good storage stability ink composition.

3. Claims 13, 16 & 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. (# US 5888287) in view of Fukui. (# JP 2000-191973).

Brown et al. discloses a water-based ink for ink jet recording including a dispersible coloring agent (column: 2, line: 39-60); a propylene glycol ether (column: 2, line: 1-15); and a surfactant (column: 2, line: 20-40). They also disclose that the amount of surfactant is added in amount from 0.1 to 3% (see Examples).

Brown et al. discloses all the limitation of the water-based ink except that the surfactant represented by the general formula:  $R_1-O-(CH_2CH_2O)_n-SO_3M$ , wherein  $n$  represents an integer of 2 to 4,  $R_1$  represents an alkyl group having a number of carbon atoms of 12 to 15 and  $M$  represents Na or triethanolamine.

Fukui teaches that the ink composition having the good storage stability characteristics, the ink composition includes a surfactant, which has a general formula  $R-O-(CH_2CH_2O)_n-SO_3M$ , wherein  $n$  is 2 to 50,  $R$  is alkyl group having 10 to 20 carbon atom, and  $M$  is organic amines or alkanolamines (see Abstract; [0008]-[0010]).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the ink composition of Brown et al. by the aforementioned teaching of Fukui in order to have the good storage stability ink composition.

4. Claims 19 & 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouchi et al. (# US 2001/0045175) in view of Fukui. (# JP 2000-191973) as applied to claims 13 & 15-18 above, and further in view of Horii et al. (# US 6871941).

Ouchi et al. and Fukui discloses all the limitation of the ink composition except that the ink flow passage formed of an Ni-Fe alloy.

Horii et al. teaches that to have a high quality print head, inkjet head has a ink flow passage is formed of an Ni-Fe alloy (column: 14, line: 50-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the ink passage of Ouchi et al. as modified by the aforementioned teaching of Horii et al. in order to have high quality print head.

5. Claims 19 & 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kappele et al. (# US 6063834) in view of Fukui. (# JP 2000-191973) as applied to claims 13 & 15-18 above, and further in view of Horii et al. (# US 6871941).

Kappele et al. and Fukui discloses all the limitation of the ink composition except that the ink flow passage formed of an Ni-Fe alloy.

Horii et al. teaches that to have a high quality print head, inkjet head has a ink flow passage is formed of an Ni-Fe alloy (column: 14, line: 50-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the ink passage of Kappeler et al. as modified by the aforementioned teaching of Horii et al. in order to have high quality print head.

### ***Allowable Subject Matter***

6. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

1. Applicant's arguments filed 11/11/2008 have been fully considered but they are not persuasive. Applicant argued that the Fukui teaches the self dispersible ink, and Ouchi et al. teaches the dispersed ink composition, it is not obvious to combine the two references, Which is not persuasive. Examiner used the Fukui reference only for surfactant formula. The primary reference teaches all the limitation of the ink composition, even the surfactant also only thing it's not teaching the formula of the surfactant, therefore examiner use the Fukui reference to show only the formula of the surfactant. The primary reference teaches that one of ordinary skill in the art, person can use any kind of surfactant in the ink composition. Therefore, it is obvious to combine the Fukui reference. Other primary references are also teaches the all the

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limitation of the ink composition except the formula of the surfactant, therefore it is obvious to combine the Fukui with the other primary references.

### ***Conclusion***

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manish S. Shah whose telephone number is (571) 272-2152. The examiner can normally be reached on 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Manish S. Shah/  
Primary Examiner  
Art Unit 2853

/MSS/